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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: Hild *et al.*

Confirmation No.: 9182

Serial No.: 09/532,937

Group Art Unit: 2143

Filed: April 22, 2000

Examiner: David E. England

For: METHOD AND SYSTEM FOR DESIGNATING REQUIRED DEVICE ATTRIBUTES
FOR EMBEDDING IN A WORLD-WIDE WEB DOCUMENT REQUEST

Date: July 5, 2005

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Erin A. Campion

APPELLANTS' REPLY BRIEF ON APPEAL UNDER 37 C.F.R. §41.41

Sir:

This Reply Brief is filed in response to the Examiner's Answer mailed May 5, 2005.

It is not believed that an extension of time and/or additional fee(s) are required, beyond those that may otherwise be provided for in documents accompanying this paper. In the event, however, that an extension of time is necessary to allow consideration of this paper, such an extension is hereby petitioned for under 37 C.F.R. §1.136(a). Any additional fees believed to be due in connection with this paper may be charged to Deposit Account No. 09-0461.

I. Grouping of Claims

The Examiner's Answer states that the rejection of groups 1 through 9 as set out on pages 6 and 7 of Appellants' Brief on Appeal (hereinafter "Appellants' Brief") stand or fall together. Appellants submit that the groups do not all stand or fall together as many of the claims are separately patentable. As stated in 37 C.F.R. §41.37(c) claims argued separately in the argument section of the brief should be placed under separate headings identifying the claims by number. Thus, the claims identified in the headings of Appellants' Brief stand or fall together. For example, 1, 2, 11, 12, 21 and 22 stand or fall together, Claims 6, 16 and 26 stand or fall together and so on.

Each of the groups of claims identified in the headings of Appellants' Brief on Appeal are directed to separately patentable subject matter, and Appellants' provided specific sections arguing the patentability of each of these separate claim groups in the Appellants' Brief as required under 37 C.F.R. § 41.37(c)(1)(vii). While claims within each of these groups stand or fall together, the claims set out in groups 1-9 do not necessarily stand or fall together, contrary to the assertions in the Examiner's Answer.

Appellants apologize for the typographical error in section 10 of the Grounds of Rejection to Be Reviewed on Appeal. Instead of Claims "9, 9 and 29", it should recite Claims "9, 19 and 29."

II. The Examiner's Answer – Response to Arguments (starting at Page 20)

Appellants will refrain here from readdressing all of the deficiencies with the pending rejections and, therefore, in the interest of brevity Appellants' hereby incorporate herein the arguments set out in Appellants' Brief on Appeal as if set forth in their entirety. Accordingly, Appellants will only address new arguments made in the Examiner's Answer Brief. Appellants believe that the Board may find this helpful in evaluating the propriety of the pending rejections.

A. Claims 1, 11 and 21

The Examiner's Answer first argues that Appellants' claim language is subject to multiple interpretations and that Appellants do not define the elements of the claims. *See* Examiner's Answer, page 20. As a preliminary note, Appellants clearly describe a link element and client properties in Figures 5A through 5C and the corresponding text of the specification. Furthermore, on pages 20 through 25 of the Examiner's Answer, the Examiner again sets out why the teachings of Merriman, when interpreted broadly, teach the recitations of Claims 1, 11 and 21 of the present application. Again, Appellants disagree that Merriman anticipates the teachings of Claims 1, 11 and 21.

In the interest of brevity, Appellants will not address each and every statement made in the Examiner's Answer with which Appellants disagree. Instead, Appellants will explain why Merriman does not anticipate Claims 1, 11 and 21 of the present invention. Claims 1, 11 and

21 of the present invention recite receiving a link element including a plurality of **requested client properties**, selecting the link element to request a document identified by the link element to be transmitted to a client and inserting at least one of the plurality of **requested client properties** into the request so as to allow **customization of the requested document** identified by the link element based on the inserted at least one of said plurality of requested client properties. In other words, particular client properties are requested in the link element and ones of these requested properties are inserted into the request.

The Examiner's Answer points to the user's IP address and cookies as providing the requested client properties as recited in Claims 1, 11 and 21. *See* Examiner's Answer, pages 20-25. Cookies, by definition, are files on a user's hard drive, kept, for example, in one of the subdirectories under the browser file directory, that can be used by Web sites to record data about the user. For example, some ad rotation software uses cookies to see which ad the user has just seen so that a different ad will be rotated into the next page view. The cookie is stored on the user's machine by the web service, not the user, thus, the user has no control over the content of the cookie. Accordingly, the user has no control over the information sent in the cookie. Merriman discusses the use of cookies and the like to tailor ads placed around a requested document as discussed in detail in Appellants' Brief.

In contrast, as discussed above and in Appellants' Brief, the link element includes one or more requested client properties and one or more of those properties are provided in the request. The ones of the properties provided are then used to customize the document, not the ads or information around the document. Nothing in Merriman discloses or suggests these recitations of the claims of the present invention. Thus, as discussed in Appellants' Brief, the Court of Appeals for the Federal Circuit has held that a finding of anticipation requires absolute identity for each and every element set forth in the claimed invention. *See Trintec Indus. Inc. v. Top-U.S.A. Corp.*, 63 U.S.P.Q.2d 1597 (Fed. Cir. 2002). Merriman clearly does not recite each and every element set forth in the claimed invention. Thus, Merriman does not anticipate the claims of the present invention for the reasons discussed herein and in Appellants' Brief. Accordingly, Appellants respectfully request reversal of the rejections of Claims 1, 11 and 21 for at least these additional reasons.

B. Claims 6, 16 and 26

The Examiner's Answer states that Appellants arguments with respect to Claims 6, 16 and 26 fail to comply with 37 C.F.R. § 111(b) "because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." See Examiner's Answer, page 26. Appellants submit that Claims 6, 16 and 26 contain recitations identical to those of Claims 1, 11 and 21, respectively. For example, Claim 6 recites:

In a networked environment, a method for designating client properties comprising:

receiving a link element associated with a server, the link element including a plurality of requested client properties;

selecting said link element to request a document identified by the link element to be transmitted to a client; and

inserting at least one of said plurality of requested client properties into the request so as to allow customization of the requested document identified by the link element based on the inserted at least one of said plurality of requested client

properties, wherein said plurality of requested client properties includes at least one property that is designated as a mandatory property and at least one property that is an optional property.

The highlighted recitations of Claim 6 are identical to the recitations of Claim 1. Thus, contrary to the Examiner's statement, Appellants clearly pointed out how the language of the claims patentably distinguish them from the references. In the interest of brevity, Appellants chose not to repeat the identical argument with respect to Claims 6, 16 and 26 and stated that "Claims 6, 16 and 26 are patentable for at least the reasons discussed above with respect to Claims 1, 11 and 21." Appellants respectfully submit that this argument is in compliance with 37 C.F.R. § 1.111(b) for at least these reasons. Accordingly, Appellants respectfully request reversal of the rejections of Claims 6, 16 and 26 for at least these additional reasons.

C. Claims 7, 17 and 27

The Examiner's Answer states that Appellants arguments with respect to Claims 7, 17 and 27 fail to comply with 37 C.F.R. § 111(b) "because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." See Examiner's Answer, page 26. Appellants, again, disagree. Claims 7, 17 and 27 recite details of the inserting step of Claims 1,

11 and 21, respectively. Appellants discussed in detail how the references did not disclose or suggest the inserting step of Claims 1, 11 and 21. Thus, it follows that if the inserting step of Claims 1, 11 and 21 is not disclosed or suggested by the references, then neither are the details of the inserting step as recited in Claims 7, 17 and 27. Appellants submit that this argument is in compliance with 37 C.F.R. § 1.111(b) for at least these reasons. Accordingly, Appellants respectfully request reversal of the rejections of Claims 7, 17 and 27 for at least these additional reasons.

D. Claims 9, 19 and 29

The Examiner's Answer states that Bruck is not relied on for particular recitations of these claims. See Examiner's Answer, page 27. Appellants would like to point out that these claims stand rejected over Merriman, Heidorn, Gerhsman and Bruck. However, Bruck is not specifically set out in the rejection of the Final Office Action. See Final Office Action, pages 11 and 12. Thus, Appellants addressed both Bruck and Gershman in Appellants' Brief so as to address all possible rejections.

Furthermore, the Final Office Action and Examiner's Answer combine four references to provide the teachings of Claims 9, 19 and 29. See Final Office Action pages 11 and 12 and Examiner's Answer pages 14 and 15. When combining references, there must be some teachings in the art or in the references that would suggest the combination of references. The more references that must be combined to provide the teachings of a single claim, the less the likelihood that the combination would be obvious. The combination of four references to teach the recitations of a single claim clearly shows that Appellants' disclosure was used as a road map to combine these references as suggested by the Examiner. The case law is clear that such a use of Appellants' disclosure is clearly prohibited. There is no motivation to combine the four cited references to provide the teachings of Claims 9, 19 and 29 as suggested by the Examiner.

Finally, the Examiner's Answer states that Appellants' arguments with respect to Claims 9, 19 and 29 fail to comply with 37 C.F.R. § 111(b) "because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." See Examiner's Answer, page 29. Appellants, again, disagree. Appellants' Brief clearly discusses the teachings

of the cited references and clearly points out that none of the cited references disclose or suggest "prompting a user whether to transmit the selected ones of the plurality of requested client properties" or "transmitting the request without at least one of the selected ones of the plurality of requested client properties if the user indicates the selected ones of the plurality of requested client properties are not to be sent" as recited in Claims 9, 19 and 29.

Appellants submit that these arguments are in compliance with 37 C.F.R. § 1.111(b) for at least these reasons. Accordingly, Appellants respectfully request reversal of the rejections of Claims 9, 19 and 29 for at least these additional reasons.

E. Claims 10, 20 and 30

The Examiner's Answer states that Appellants arguments with respect to Claims 10, 20 and 30 fail to comply with 37 C.F.R. § 111(b) "because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." *See Examiner's Answer, page 29.* Appellants, again, disagree. Claims 10, 20 and 30 recite details of terminating a request. Appellants discussed in detail how the references did not disclose or suggest designating mandatory properties. Thus, it follows that if none of the properties are designated as mandatory, then terminating the request based on the mandatory status of the property as recited in Claims 10, 20 and 30 is not disclosed or suggested by the references. Appellants submit that this argument is in compliance with 37 C.F.R. § 1.111(b) for at least these reasons. Accordingly, Appellants respectfully request reversal of the rejections of Claims 10, 20 and 30 for at least these additional reasons.

F. Claims 37, 40 and 43

The Examiner's Answer states that Appellants' arguments with respect to Claims 37, 40 and 43 fail to comply with 37 C.F.R. § 111(b) "because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references." *See Examiner's Answer, page 31.* Appellants, again, disagree. Appellants' Brief clearly sets out the cited passage of Gershman and discusses why these teachings in the cited passage fail to disclose or suggest the recitations of

Claims 37, 40 and 43. Appellants submit that these arguments are in compliance with 37 C.F.R. § 1.111(b) for at least these reasons.

Furthermore, responsive to Appellants' arguments with respect to the combination of references, the Examiner's Answer states "as can be seen by numerous areas of the cited art, there are other reasons, not stated by the Examiner, that would give reasons to combine the prior arts of record." *See* Examiner's Answer, page 31. The Examiner fails to point to any of these "numerous areas" or "other reasons" and, therefore, fails to satisfy his burden of pointing out a specific motivation to combine in the art or the cited references. Accordingly, Appellants respectfully request reversal of the rejections of Claims 37, 40 and 43 for at least these additional reasons.

G. The 112 Rejections

Appellants would like to thank the Examiner for withdrawing the 112 rejections with respect to Claims 37, 40 and 43, Claims 38, 41 and 44 and Claims 9, 19 and 29.

H. The Drawing Objections

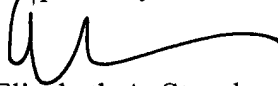
The Examiner's Answer states that the Figures do not illustrate selecting less than all of the available client properties. *See* Examiner's Answer, pages 34-35. Appellants disagree. Figure 5A illustrates the PROFILEATTRS, which designates a list of client properties that may be provided to the server from which the document is requested. As illustrated therein and described in the corresponding text, the PROFILEATTRS of Figure 5A only includes one client property, HardwareCharacteristics 346. As stated in the specification, "[t]he list 345 includes only one property...Additional properties may be included in the list 345 by separating them with a semi-colon." *See* Specification, page 13, lines 9-12. Thus, implying that there is more than one available client property. Thus, Figure 5A clearly illustrates the requested client properties being less than all available client properties as recited in dependent Claims 37, 40 and 43. *See* Figure 5A and the specification, page 13, lines 6-12. Accordingly, Appellants respectfully submit that the drawings are in compliance with 37 C.F.R. 1.83(a) for at least the reasons discussed above. Appellants respectfully request withdrawal of the objections with respect to the drawings.

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III. Conclusion

For the reasons set forth in above and in Appellants' Brief on Appeal, Appellants request reversal of the rejections of the claims, allowance of the claims and passing of the application to issue.

Respectfully submitted,



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